

REMARKS/ARGUMENTS

Claims 21-93 are pending in the application of which claims 21-73 and 85-93 have been withdrawn from consideration and claims 74-84 stand rejected. Claims 85-93 were added in the last response, but have been withdrawn as being directed to a non-elected invention. Claim 74 has been amended above. No new claims have been added, nor have any claims been deleted. Accordingly, claims 74-84 are still pending in the application of which claim 74 is independent.

Claim Rejections Under § 103

Paragraph 4 of the Action rejects claims 74-80 under 35 U.S.C. § 103(a) as being unpatentable over Vincent (U.S. Patent 5,447,309) in view of Ryan (U.S. Patent 5,947,840) in further view of McCabe (U.S. Patent 6,306,048). Applicant respectfully traverses the rejection because Vincent, Ryan, and McCabe, alone or in combination, fail to teach, suggest, or disclose each and every element of the claims. There is the further issue that McCabe cannot support a *prima facie* case of obviousness because it is improperly combined with Vincent and Ryan.

Applicant has previously pointed out that Vincent fails to teach, suggest or disclose using inserts of a given weight in the crown and sole configured to achieve a desired center of gravity. In response, the present Action combines Vincent with Ryan and McCabe alleging that these two references teach that inserts can be inserted into a club head in order to achieve a desired center of gravity without effecting the overall weight. Specifically with respect to Ryan, figures 10 and 11 are cited, wherein the center of gravity is shifted horizontally by changing weight configurations in heel and toe inserts.

In certain embodiments described in the present application, the center of gravity of the club can be moved vertically up or down without changing the overall weight of the club head.

This is important because it allows the golfer to test various centers of gravity without effecting other variables such as swing weight. The ability to move the center of gravity in a vertical direction, without effecting other variable, is important because it allows the golfer to determine the optimum combination of launch angle, spin rate, and velocity. Three factors the inventors determined are key for optimizing a golfer's carry distance and total distance when striking a golf ball. (See, e.g., the tables on page 12 and the accompanying description).

Accordingly, claim 74 as amended claims “[a] club head, comprising . . . a crown comprising a fitting configured to receive an insert, the insert comprising a weight configured to *move the center of gravity vertically, either up or down, without effecting the overall weight* of the club head, and a sole plate comprising a fitting configured to receive an insert, the insert comprising a weight configured to *move the center of gravity vertically, either up or down, without effecting the overall weight* of the club head.”

In contrast, while Ryan does teach that the center of gravity can be moved vertically by changing weights in heel and toe inserts, this cannot be achieved in the embodiments of Ryan without changing the overall weight despite the allegation to the contrary contained in the Action. (See figures 12-15). Accordingly, neither Vincent nor Ryan, alone or in combination, teach suggest or disclose a club head such as is claimed in claim 74. In fact, Ryan teaches away from the invention claimed in claim 74.

Thus, McCabe must make up for the deficiencies of Vincent and Ryan, which it does not. With respect to McCabe, the Action cites col. 5, lines 20-32, wherein it is taught that the swing weight can first be set by changing the weight in a chamber in the sole plate. Once the swing weight is set, the center of gravity can be altered by changing the distribution of the weight within the chamber. First, McCabe cannot support a *prima facie* case of obviousness, because

McCabe is improperly combined with Vincent and Ryan. The goal of the invention as claimed in claim 74, even prior to any amendments, is to change the center of gravity without changing the swing weight. Conversely, however, the primary purpose of McCabe is to change the swing weight. Therefore one of skill in the art would not think to combine McCabe with the Vincent and Ryan to achieve the invention as claimed in claim 74. At the very least, as is the case with Ryan, McCabe teaches away from the invention as claimed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. The third of these criteria is the prior art reference (or references when combined) must teach or suggest all the claim limitations. (See MPEP 7006.02(j)). In this case none of the references, alone or in combination, teach “[a] club head, comprising . . . a crown comprising a fitting configured to receive an insert, the insert comprising a weight configured to *move the center of gravity vertically, either up or down, without effecting the overall weight* of the club head, and a sole plate comprising a fitting configured to receive an insert, the insert comprising a weight configured to *move the center of gravity vertically, either up or down, without effecting the overall weight* of the club head,” as required by amended claim 74. Accordingly, The cited prior art cannot render claim 74 obvious.

Applicant therefore respectfully requests the rejection of claim 74 be withdrawn. Applicant also request that the rejection of claims 75-80 be withdrawn since these claims depend from claim 74, which is itself allowable over the cited prior art.

Paragraph 5 rejects claims 81-84 as being as being unpatentable over Vincent in view of Ryan in further view of McCabe as applied to claims 74-80, and in further view of Woods (U.S. Patent 6,273,828). Applicant respectfully traverses the rejection because Vincent, Ryan, McCabe, and Woods, alone or in combination, fail to teach, suggest, or disclose each and every

element of the claims. Specifically, claims 81-84 ultimately depend from claim 74. Accordingly, claims 81-84 are allowable for the reasons stated above with respect to claim 74 unless Woods makes up for the deficiencies of Vincent, Ryan, and McCabe, which it does not. Applicant therefore respectfully requests that the rejection of claims 81-84 be withdrawn.

Paragraph 6 of the Action rejects claims 74-80 under 35 U.S.C. § 103(a) as being unpatentable over Vincent (U.S. Patent 5,447,309) in view of Sahm (U.S. Patent 4,869,507) in further view of McCabe (U.S. Patent 6,306,048). Applicant respectfully traverses the rejection because Vincent, Sahm, and McCabe, alone or in combination, fail to teach, suggest, or disclose each and every element of the claims. Further, for the reasons stated above, Applicant does not believe that that McCabe can support a *prima facie* case of obviousness because it is improperly combined with Vincent and Sahm.

Again, as noted above, Vincent and McCabe, alone or in combination, do not teach each and every limitation of the claims. Therefore, Sahm must make up for the deficiencies of Vincent and McCabe, which it does not. As with Ryan and McCabe, and contrary to the assertion contained in the Action, Sahm teaches changing the swing weight, which is in direct opposition to the invention claimed, e.g., in claim 74. Specifically, as noted in the Abstract, Sahm is directed to a weighting system that uses “weights [that] are made of materials of varying density. Weighting changes can easily be effected by removing an existing set of weights and replacing them with a set made of *greater or lesser density* material. (emphasis added).”

Further, as noted in col. 4, lines 2-5, the embodiments disclosed in Sahm use three different weights of different weight and installs them in different combinations in order to alter the swing weight and weight dispersal from heel to toe. But Sahm does not teach, suggest, or

disclose the ability to change the vertical center of gravity without changing the overall weight of the club.

Accordingly, The cited prior art cannot render claim 74 obvious. Applicant therefore respectfully requests the rejection of claim 74 be withdrawn. Applicant also request that the rejection of claims 75-80 be withdrawn since these claims depend from claim 74, which is itself allowable over the cited prior art.

Paragraph 7 rejects claims 81-84 as being as being unpatentable over Vincent in view of Sahm in further view of McCabe as applied to claims 74-80, and in further view of Woods (U.S. Patent 6,273,828). Applicant respectfully traverses the rejection because Vincent, Sahm, McCabe, and Woods, alone or in combination, fail to teach, suggest, or disclose each and every element of the claims. Specifically, claims 81-84 ultimately depend from claim 74. Accordingly, claims 81-84 are allowable for the reasons stated above with respect to claim 74 unless Woods makes up for the deficiencies of Vincent, Sahm, and McCabe, which it does not. Applicant therefore respectfully requests that the rejection of claims 81-84 be withdrawn.

CONCLUSION

Based on the above amendments and remarks, Applicant believes that the claims are in condition for allowance and such is respectfully requested. Applicant believes that no additional claims fees are necessitated by this response. If any additional fees are due the Commissioner is hereby authorized to charge any additional fees required by this response to our Deposit Account No. **13-0480** (Attorney Docket No. 67175523-001101).

Respectfully Submitted,

Date: December 20, 2006

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